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3618

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: **Gerald Klebe**

Appellant: **Nick Bromer**

5. GAU: **3618**

Title: **DORSIFLEXION SKATE BRAKE**

Serial No.: **09/995,097**

Filed: **Nov. 27, 2001**

Tech Center: **3600**

This paper: **February 26, 2004**

10
**SUBMISSION OF REQUEST FOR ORAL HEARING AND
REPLY TO EXAMINER'S ANSWER**

15 Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

Attached hereto are a Request for Oral Hearing, a check for \$145 to cover the fee for the oral hearing, and (in triplicate) a Reply to the Examiner's Answer.

20 Respectfully submitted,

Nick Bromer

Nick Bromer, Appellant
Registration No. 33,478
(717) 426-1664, voice and fax
402 Stackstown Road
Marietta, PA 17547

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30 *I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450," on February 26, 2004.*

Nick Bromer [Reg. No. 33,478]

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Signature: *Nick Bromer*



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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REQUEST FOR ORAL HEARING

Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

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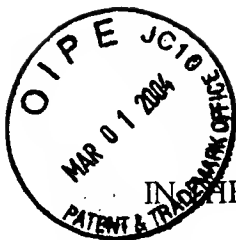
Sir:

The Appellant requests an oral hearing before the Board of Appeals. A check in the amount of \$145.00 is attached.

Respectfully submitted,

Nick Bromer

Nick Bromer, Appellant
Registration No. 33,478
(717) 426-1664, voice and fax
402 Stackstown Road
Marietta, PA 17547



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: **Gerald Klebe**

Appellant: **Nick Bromer**

GAU: **3618**

Title: **DORSIFLEXION SKATE BRAKE**

Serial No.: **09/995,097**

Filed: **Nov. 27, 2001**

Tech Center: **3600**

This paper: **February 24, 2004**

NSB

REPLY TO EXAMINER'S ANSWER

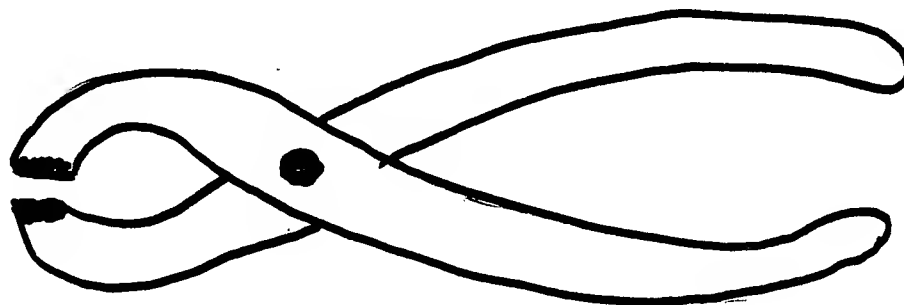
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

In response to the Answer mailed on January 6, 2004, the Appellant first notes that the Brief submitted on September 4 mis-stated the issues (on page 5, lines 5-9). The Appellant foolishly failed to note that claim 8 was rejected under new grounds, and he merely re-submitted the old Brief. The Appellant apologizes to the honorable Board for this error and any added confusion and complication (which this case certainly does not need).

To remedy this error and reduce the complication, the Appellant now stands by his error and states that claim 8 may stand or fall along with claim 2, and if this creates any problem then the honorable Board is authorized to cancel 8 without prejudice to reentry (or to direct the Examiner to cancel claim 8 without prejudice to reentry). The Appellant does *not* concede that claim 8 is obvious, but wishes to simplify the issues.

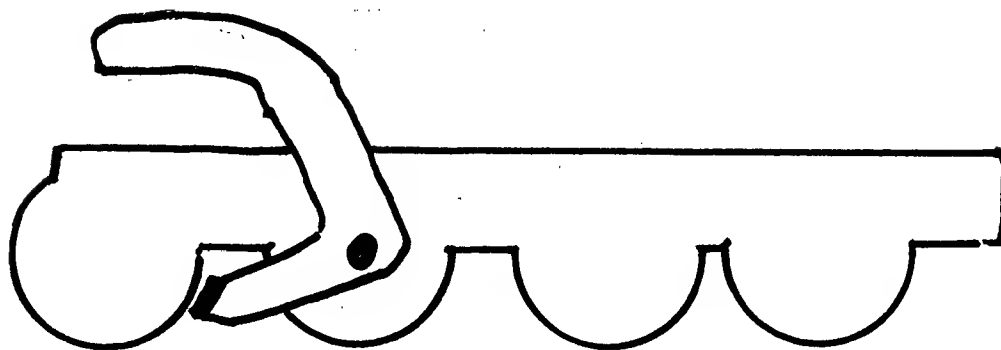
*i.e.
8 Withdrawn:
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-NSB.
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Turning now to the central issue in this case, enablement, the Appellant replies, firstly, as follows: This is a schematic view of a pair of pliers:



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And this is a schematic view of the Appellant's elected embodiment:



Both sketches show simple levers, with two movable parts and a pivot. For the Appellant's brake to operate, *all* that is required is for the brake shoe to touch the wheel. The Appellant respectfully asks: Is this really so difficult?

The Examiner maintains that a mechanical engineer¹ could not possibly make the invention from the disclosure. But the Appellant believes that a mechanical engineer, who is thoroughly familiar with levers, pivots, and brake shoes, could make the Appellant's brake work just from the sketch above. This is, literally, a simple machine. The Appellant, who is not a mechanical engineer, make the invention in his basement using an \$89.00 drill press and hand tools (this is the model which the Examiner did not want to admit into the record).

The Appellant now addresses the Examiner's Answer point by point.

(1) The Examiner is correct, Nick Bromer is the real party in interest.

(2-4) The Appellant agrees.

¹ The Appellant stated that the person skilled in the art is a mechanical engineer. The Examiner has not traversed this.

(5) The Examiner asserts that “additional” disclosure is in the Brief. This appears to be irrelevant to the issues before the Board, since the disclosure of the *specification* is at issue, and not the disclosure of the Brief. The honorable Board will have no trouble distinguishing the specification from the Appellant's remarks, and evaluating the accuracy of those remarks in relation to the specification.

In section (a) the Examiner argues based on the Appellant's mention of the word “dorsiflexion,” which appears in claim 8. As claim 8 is not separately considered, this is moot. For the record, the Appellant's remark, quoted at page 3, line 4 of the Answer, is believed accurate.

In sections (b)(i) and (b)(ii) the Examiner argues that the Appellant's discussion of the non-elected species is irrelevant. The Appellant's stated position is that the question of enablement—the central question in this case—should be based on the *entire* disclosure, and not on an election of species which reflects only the convenience of examination, and has nothing to do with what a person of skill in the art would do. If the Board agrees with the Appellant on the last point, then the discussion of non-elected species is fully relevant; if not, the Board can ignore those remarks.

In sections (c) and (d), the Examiner argues that the Appellant's discussion of shading lines in the drawing adds “additional disclosure.” The Examiner again expresses a personal opinion about the Brief, which is irrelevant because it is the task of the Board, not the Examiner, to decide if the Appellant's explanation of the invention is in line with the specification and claim language.

On page 5, line 10, the Examiner raises a new issue, i.e., best mode. Only enablement is at issue (final rejection of July 2, 2003, pages 4-5).

In section (e), the Examiner states that the pin acting as a pivot is not recited in claims 2-3. This is true. The Examiner's point is not clear.

In section (f), the Examiner argues similarly on claim 8, which is not under separate consideration by the Board, as is noted above.

In section (g), the Examiner states that Fig. 3 does “not identify the material of the brake shoe.” The Examiner's point is again unclear. As best understood, this remark relates to the question before the Board, of whether the entire disclosure or only the elected disclosure should be considered in deciding enablement.

As to section (h), the Appellant admits that discussions of claim 10 per se are irrelevant as it is not under consideration.

Section (i) is noted.

Section (j) states that the claimed return spring is not illustrated in Fig. 1. The Appellant addressed this in the paper entitled “Submission ...” of September 24, 2003, on page 2. Claim 12 is not withdrawn and the Examiner's remarks are again irrelevant to any rejection before the Board.

In section (k) the Examiner asserts that claim 13 was not discussed. The Appellant notes that this subject matter is clearly illustrated in Fig. 1 and the action of the toe on the lifter was discussed at great length in the Brief.

Section (l) appears to raise a new issue, namely that the boot B would prevent the toes from lifting the toe cap 110 of the lifter. But the specification makes it very clear that the toes *do* lift and the blatant implication is that the boot B does not interfere.

Section (m) appears to be irrelevant to the issues.

In section (n) the Examiner questions enablement regarding claim 17 on the basis of Fig. 1 assertedly showing no frame. This is believed possibly to be a new issue, as claim 17 was not discussed separately in the rejection.

(6) The Appellant agrees with the Examiner, except that the Examiner—like the Appellant—overlooked the § 103 rejection over Integnan in view of Hoskins. The Answer does not mention this oversight by the Appellant.

(7-9) The Appellant agrees.

(10) The rejections are repeated.

(11a) The Examiner explains that he is assuming that the Appellant's skate frame is conventional, and states that the pivoted member of Fig. 1 would interfere with such a conventional frame as is shown in the prior art (page 13, lines 3-6). However, the Examiner does not cite any particular prior art, and the Appellant and the Board are left to guess what structure the Examiner has in mind, and where the imagined mechanical interference might be.

"With a conventional frame," the Examiner continues, "... the instant application ... does not disclose how the [disclosed] brake structure ... would be able to function." The Appellant answers that he could not have explained how it would function in specific relation with unspecified prior art, before that art were cited.

The Examiner complains (page 13, line 10) that "the brake arms must be appropriately bent," as if this were some insurmountable task; the Examiner again underestimates the level of skill in the art.

The Appellant again asserts that the person skilled in the art, who is a mechanical engineer, could make such a simple device as the Appellant's in such a way that it would function without "structural interference," even if the Examiner himself cannot imagine how to do this.

The Examiner again asserts that the structure of Fig. 1 "appears to be planar," despite the shading lines and the specification's statement that the second arm extension 120 of Fig. 1 "widens to meet the edges of a toe cap lifter 110" (page 8, line 19; emphasis added).

(11b) (i) The Examiner addresses "dorsiflexion," which is believed no longer to be at issue in view of the Appellant's opening statement above.

(ii) The Appellant agrees that Integnan's strident teachings against using the toes are not directly relevant in a novelty rejection, but they are believed to be indirectly relevant in emphasizing that Integnan does *not* disclose using the toes to brake.

(iii) The Examiner asserts that Integnan's Figs. 3A and 2A show the toe moving upward. However, the Examiner seems to reverse the temporal order of these figures. Fig. 2A shows the "normal position" of the foot (col. 3, line 62) while Fig. 3A shows the foot in "position for braking" (col. 4, line 3). Thus, the toe is pressed down while braking. The honorable Board is also referred to col. 4, lines 57-64, and col. 5, line 2, reading "the movement of the entire foot or feet as a whole ... is being utilized."

The Examiner again discusses "dorsiflexion," which should no longer be at issue as the Appellant is no longer contesting claim 8.

(11c) (i)-(iii) The Examiner asserts that Carlsmith discloses braking by raising the front portion of the foot, and that claim 16 is anticipated because the toes move as part of the foot. However, Carlsmith states (col. 10, line 7), "Braking action with the assembly of the present invention is accomplished when the skater pushes down with his or her heel on the boot 62." Thus, according to the reference itself, the front portion of the foot is not used to actuate the brake. The honorable Board is also referred to col. 10, lines 22, 25, 46, 49-50, 60, 66, and 68, and line 4 of the abstract, all stating that the brake acts by down-pressing the heel, not by up-pressing the top of the foot like Integnan.

Furthermore, the Examiner is considered to read the claim language too broadly, so that even if there were any disclosure of the brake being actuated by raising the front of the foot (there is none), that would still be outside the scope of "actuating the brake by pressing upward the toe of the user." As the Appellant has noted, pressing upward only the toes would have no effect in the Carlsmith brake, because the entire foot must move.

(iv) The Appellant's specification naturally states the invention broadly, since the allowable scope was unclear at the time of writing. There is no legal basis for the Examiner to judge the scope of the claims based on broad statements in the specification. Applicants almost always narrow the scope of their claims during prosecution; the claims are examined, not the specification. The Examiner's remark is irrelevant to the issues and is also unfair, because the

